



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,894	07/21/2006	Francis Sean Moolman	ADADA4.001APC	5369

20995 7590 01/30/2009  
KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
----------

KOSSON, ROSANNE

ART UNIT	PAPER NUMBER
----------	--------------

1652

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/30/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,894	<b>Applicant(s)</b> MOOLMAN ET AL.	
	<b>Examiner</b> Rosanne Kosson	<b>Art Unit</b> 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1652

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-21, 30 and 31, drawn to a method of making an emulsion of cross-linked, immobilized enzyme particles, in which a surfactant is added to one or both phases of the emulsion to increase enzyme activity.

Group 2, claim(s) 1-20, 22, 30 and 31, drawn to a method of making an emulsion of cross-linked, immobilized enzyme particles, in which a precipitator is added to one or both phases of the emulsion to precipitate the emulsion onto the emulsion interfaces.

Group 3, claim(s) 1-20, 23, 30 and 31, drawn to a method of making an emulsion of cross-linked, immobilized enzyme particles, in which an additive is added to one or both phases of the emulsion to modify one or more of the following properties: pH; ionic strength; viscosity; magnetic properties; agglomeration tendency; and/or zeta potential of the emulsion and/or the enzyme particles.

Group 4, claim(s) 24-28, drawn to a particle comprising cross-linked, immobilized enzymes.

Group 5, claim(s) 29, drawn to a method of carrying out an enzymatic reaction, by catalyzing it with particle comprising cross-linked, immobilized enzymes.

The inventions listed as Groups 1-5 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

The requirement of unity of invention is not fulfilled because there is no technical relationship among these inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Therefore, a technical relationship is lacking among the claimed inventions involving one or more special technical features. The technical feature that links the five groups of inventions is particles of a cross-linked, immobilized enzyme.

The inventions of Groups 1-5 do not share the common special technical feature of particles of

Art Unit: 1652

a cross-linked, immobilized enzyme, because Clark, Jr. (US 6,343,225 B1) disclose an oil-in-water emulsion containing particles of an immobilized enzyme (glucose oxidase) that is cross-linked with a chemical agent such as glutaraldehyde (see col. 5, lines 20-35; col. 8, lines 23-59; and col. 9, line 16, to col. 10, line 6).

Thus, the technical feature of particles of a cross-linked, immobilized enzyme does not define the invention over the prior art. Because the common technical feature is not novel (special) with respect to the cited reference, it is clear that the claims of Groups 1-5 lack a single common technical feature that defines them over the prior art.

Further, an international application containing claims to different categories of inventions will be considered to have unity of invention if the claims are drawn only to one of certain combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
  - (2) A product and process of use of said product; or
  - (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
  - (4) A process and an apparatus or means specifically designed for carrying out the said process; or
  - (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process (see 37 CFR 1.475(b)-(d)).
- In the instant case, the claims are drawn to a product and multiple processes, only a particular combination of which including Group 1 may be considered for unity of invention, i.e., Group 1, Group 4 and Group 5, (the first named product, the first named process of making the product and the first named process of using the product). Other groups are drawn to additional processes, and other combinations do not comply with the aforementioned Rules. But, because a corresponding special technical feature is not present, Groups 1, 4 and 5 cannot be considered to have unity of invention.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- a) In claims 2-3, if one of Groups 1-3 is elected, Applicant must elect whether the particles are porous (claim 2) or non-porous (claim 3).
- b) In claim 8, if one of Groups 1-3 is elected, Applicant must elect whether the emulsion is an oil-in-water emulsion or a water-in-oil emulsion.

Art Unit: 1652

c) In claim 16, if one of Groups 1-3 is elected, Applicant must elect one of the hydrophobic phases listed in the claim.

d) In claim 23, if one of Groups 1-3 is elected, Applicant must elect one of the properties listed in the claim that is modified by the additive. Because of the "and/or" conjunctions, Applicant may also elect a combination of two or more properties. If a combination is elected, Applicant must indicate the precise number and identity of the properties that are modified.

Applicant is required, in reply to this action, to elect a single species in a) – d) above to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: 1, 7 and 20.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons. Porous vs. non-porous particles is a mutually exclusive feature. Oil-in-water vs. water-in-oil are two different types of emulsions, each having different biological, chemical and physical properties. Each hydrophobic phase has a different chemical structure and different chemical and physical properties. Each property, or combination of properties, listed in claim 23 is a different chemical and physical property. For example, magnetic particles are different from those having a high or low pH. Because the claimed species are not art-recognized equivalents, a holding of lack of unity of invention is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the

Art Unit: 1652

allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

**Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosanne Kosson whose telephone number is 571-272-2923. The examiner can normally be reached on Monday-Friday, 8:30-6:00, alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat Nashed, can be reached on 571-272-0934. The fax phone number for the

Art Unit: 1652

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rosanne Kosson  
Examiner, Art Unit 1652

rk/2009-01-27  
/David M. Naff/  
Primary Examiner, Art Unit 1657